



PATENT
Attorney Docket No. 09812.0524-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Shinichi HASEGAWA et al.)	Group Art Unit: 3663
)	
Application No.: 10/822,072)	Examiner: Tuan C. To
)	
Filed: April 8, 2004)	
)	
For: ONBOARD APPARATUS,)	Confirmation No.: 2104
NAVIGATION SYSTEM, AND)	
METHOD FOR SETTING DISPLAY)	
SCREEN)	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action mailed March 25, 2008. This Request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants have met each of the requirements for a pre-appeal brief review of rejections set forth in an Office Action. The application has been at least twice rejected. Applicants have filed a Notice of Appeal with this Request, and have not yet filed an Appeal Brief. Applicants submit this Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005.

II. Status of the Claims

In the Final Office Action, the Examiner rejected claims 1, 12, 14, and 16 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Pub. No. 2003/0097211 to Carroll et al. ("*Carroll*"); rejected claims 2 and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Carroll* and U.S. Patent Application Pub. No. 2004/0210363 to Kataghishi ("*Kataghishi*"); and rejected claim 13 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Carroll* and U.S. Patent Application Pub. No. 2005/0203684 to Borgesson ("*Borgesson*").

III. The rejection of Claims 1, 12, 14, and 16 under 35 U.S.C. § 102(e) as being anticipated by *Carroll* is improper

Applicants respectfully traverse the rejection of claims 1, 12, 14, and 16 under 35 U.S.C. § 102(b).

Independent claim 1 recites an apparatus including, for example, "means for automatically getting vehicle model information from the vehicle by determining a shape of a connector used to attach the onboard apparatus to the vehicle." Independent claim 14 recites an apparatus including, for example, "getting means for automatically getting vehicle model information from the vehicle by determining a formed position of a connector used to attach the onboard apparatus to the vehicle."

Carroll fails to teach or suggest at least the claimed means for getting either claim 1 or claim 14. Indeed, rather than pointing to some disclosure of *Carroll*, the Final Office Action improperly asserts inherency.

According to M.P.E.P § 2131.01, "[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be

filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)."

According to the Final Office Action, *Carroll* discloses "[a]n OBD-II is used as an on-board apparatus mounted on a motor vehicle for diagnosing the vehicle on board system . . . OBD-II is connected to a connector exited on-board of a motor vehicle model" (page 6). The Final Office Action further states, "OBD-II inherently includes a determination of a 'shape' or 'formed position' of such the connector when the connection is completed" (page 6).

The Final Office Action fails to rely on extrinsic evidence for the assertion that the subject matter of claims 1 and 14 is inherent. According to *Carroll*, OBD-II is "an on-board signal outlet" (paragraph 0025). "[D]etermination of a 'shape' or 'formed position'" (emphasis added) is not inherent to connecting a connector to an outlet. Inherency requires a "necessary presence" not an unsupported, undocumented, occurrence. Furthermore, even if the assertion that "OBD-II inherently includes a determination of a 'shape' or 'formed position'" is correct, it does not constitute "getting vehicle model information . . . by determining a shape of a connector," as recited in claim 1, or "getting vehicle model information . . . by determining a formed position of a connector," as recited in claim 14 (emphasis added). Therefore, the Final Office Action's rejection of claims 1 and 14 based on inherency is improper.

Claims 12 and 16 depend from claims 1 and 14, respectively, and are thus allowable over *Carroll*, for at least the same reasons as claim 1 and claim 14.

IV. The rejection of Claims 2 and 15 under 35 U.S.C. §103(a) as being unpatentable over *Carroll* and *Kataghishi*

Applicants respectfully traverse the rejection of claims 2 and 15 under 35 U.S.C. §103(a).

Claims 2 and 15 depend from claims 1 and 14, respectively, and are thus allowable over *Carroll*, for at least the same reasons as claim 1 and claim 14, respectively. *Kataghishi* does not repair the deficiencies of *Carroll*, at least because *Kataghishi* fails to disclose the means for getting of claim 1 or claim 14.

Accordingly, *Carroll* and *Kataghishi* fail to render the subject matter of claims 2 and 15 obvious.

V. The rejection of Claims 13 and 17 under 35 U.S.C. §103(a) as being unpatentable over *Carroll* and *Borgesson*

Applicants respectfully traverse the rejection of claims 13 and 17 under 35 U.S.C. §103(a).

Claims 13 and 17 depend from claims 1 and 14, respectively, and are thus allowable over *Carroll*, for at least the same reasons as claim 1 and claim 14, respectively. *Borgesson* does not repair the deficiencies of *Carroll*, at least because *Borgesson* fails to disclose the means for getting of claim 1 or claim 14.

Accordingly, *Carroll* and *Borgesson* fail to render the subject matter of claims 13 and 17 obvious.

IV. Conclusion

In view of the foregoing, claims 1, 2, and 12-16 are in condition for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: June 19, 2008

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